



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,704	12/27/2001	Thomas E. Murphy	01286	9260
38516 7590 10/15/2008 SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519				
EXAMINER				
VAN HANDEL, MICHAEL P				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
10/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/026,704

Applicant(s)

MURPHY ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 7/18/2008. Claims **19-31** are pending. Claims **19, 30** are amended. Claims **1-18** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **19** and **30**, filed 7/18/2008, have been fully considered, but they are not persuasive.

Regarding claims **19** and **30**, the applicant argues that DeWeese et al. does not teach or suggest reducing a displayed image to a first quadrant of a display of the television, such that a second, third, and fourth quadrants are blank, displaying a first message in two horizontal, adjacent blank quadrants, and displaying a second message in a remaining blank quadrant. The examiner respectfully disagrees. DeWeese et al. discloses a television chat system 10 as shown in Figure 1A. DeWeese et al. further discloses a television display screen 295 that illustrates how the set-top box application may allow the user to participate in a plurality of chat groups concurrently. A television program called News Program is displayed in upper left quadrant 315 of television display screen 295. The user can watch News Program and participate concurrently in three different chat groups displayed in quadrants 316, 317, and 318. Textual real-time communications from two chat rooms are displayed in upper right quadrant 316 and lower left quadrant 317. Each chat topic relates to issues discussed on News Program. The topic of the chat room in quadrant 316 is Clinton's Impeachment. The topic of chat room in quadrant 317 is

Lewinsky's Testimony. The video image of a participant in a third video chat group is displayed in quadrant 318 (p. 11, paragraph 119 & Fig. 16). In Figure 16, DeWeese et al. illustrates the television program being reduced and displayed in 315, the message "THINK" being displayed in horizontal, adjacent quadrants 316 and 317, and another video message being displayed in quadrant 318 (Fig. 16). As such, the examiner maintains that DeWeese et al. meets the limitation of "a displayed image is reduced in size to a first quadrant of a display of the television, thus leaving second, third, and fourth quadrants as blank margins, the processor causing a first message to be displayed in two horizontal, adjacent blank quadrants, and the processor causing a second message to be displayed in a remaining blank quadrant," as currently claimed.

Further regarding claims **19** and **30**, the applicant argues that DeWeese et al. does not teach or suggest updating the message information using private data in an MPEG transport stream received from the external line connection to the external signal source. The examiner respectfully disagrees. The examiner first notes that the features upon which applicant relies (i.e., using private data in an MPEG transport stream) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

DeWeese et al. discloses that the text-based, audio, or video chat communications are distributed over communications paths 24 in real-time (p. 3, paragraph 55). Real-time communications, such as chat messages are sent back and forth between the participants of the chat group (p. 3, paragraph 57). As such, the messages are constantly updated via communications paths 24. DeWeese et al. further discloses that the chat system may be set up so

that a user must obtain permission from a second user before he is able to chat with the user (p. 7, paragraph 86). As such, the examiner interprets the communications between these users to be private. This meets the limitation of “means for updating the message information using private data received from the external line connection to the external signal source,” as currently claimed.

Still further regarding claims **19** and **30**, the applicant argues that DeWeese et al. does not teach or suggest when a message is created, first storing the message in memory for a time prior to being sent, then retrieving the message from the memory and sending the message to a recipient’s set top box. The examiner respectfully disagrees. DeWeese et al. discloses a user interface 32 for allowing a user to compose a message. As the user selects characters and presses enter, the chat application retains the entered characters until the message is sent (p. 5, paragraph 68; p. 8, paragraph 94; & Fig. 1C). This meets the limitation of “when a message is created, first storing the message in memory for a time prior to being sent, then retrieving the message from the memory and sending the message to a recipient’s set top box,” as currently claimed. DeWeese et al. further discloses that the user may compose messages by selecting from a list of standard messages 70 or words 72 displayed in display screen 75 (p. 5, paragraph 69 & Fig. 1D). This also meets the limitation of “when a message is created, first storing the message in memory for a time prior to being sent, then retrieving the message from the memory and sending the message to a recipient’s set top box,” as currently claimed. DeWeese et al. still further discloses that the user can store a nickname for himself in box 133. The nickname can be used for anonymity in a chat group or as a creative pseudonym related to the chat topic (p. 6, paragraphs 76, 78 & Fig. 4). This also meets the limitation of “when a message is created, first

storing the message in memory for a time prior to being sent, then retrieving the message from the memory and sending the message to a recipient's set top box," as currently claimed.

DeWeese et al. still further discloses that real-time communications can be stored on the chat server (p. 8, paragraph 98 & Figs. 2A, 3). This also meets the limitation of "when a message is created, first storing the message in memory for a time prior to being sent, then retrieving the message from the memory and sending the message to a recipient's set top box," as currently claimed.

Still further regarding claims **19** and **30**, the applicant argues that DeWeese et al. fails to teach or suggest an external line connection to an external signal source. The examiner respectfully disagrees. The communications lines 24 of DeWeese et al. illustrate an external line connection to a television distribution facility (Fig. 1A). This meets the limitation of "an external line connection to an external signal source," as currently claimed.

Still further regarding claims **19** and **30**, the applicant argues that DeWeese et al. fails to teach or suggest an internal wiring system connected to the external line connection, the internal wiring system distributing signals from a service provider throughout the subscriber's dwelling. The examiner respectfully disagrees. DeWeese et al. discloses distributing the signals from the television distribution facility throughout a household to a set-top box (p. 6, paragraph 80 & Fig. 1A). This meets the limitation of "an internal wiring system connected to the external line connection, the internal wiring system distributing signals from a service provider throughout the subscriber's dwelling," as currently claimed.

Still further regarding claims **19** and **30**, the applicant argues that DeWeese et al. fails to teach or suggest multiple set top boxes in communication with the internal wiring system, each

set top box having a first input connected to the internal wiring system for receiving broadcasted content from the service provider. The examiner respectfully disagrees. DeWeese et al. discloses multiple set-top boxes 26 within multiple user television equipment 20. Each of the user television equipment has an input (over communication lines 24) for receiving television signals from the television distribution facility. Each of these inputs at each of these user television equipment is connected to the wiring of user television equipment within each household via television distribution facility in order to provide real-time chat communications (Figs. 1A, 2A, 2B, 3, 10). This meets the limitation of “multiple set top boxes in communication with the internal wiring system, each set top box having a first input connected to the internal wiring system for receiving broadcasted content from the service provider,” as currently claimed.

Still further regarding claims **19** and **30**, the applicant argues that DeWeese et al. fails to teach or suggest when the message information is received at at least one of the multiple set top boxes, a processor in a receiving set top box receives text information along with formatting information from a sending set top box. The examiner respectfully disagrees. DeWeese et al. discloses, in addition to receiving text information, also receiving formatting information of the text information, such as capital letters (p. 5, paragraph 68 & Figs. 16). This meets the limitation of “when the message information is received at at least one of the multiple set top boxes, a processor in a receiving set top box receives text information along with formatting information from a sending set top box,” as currently claimed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **19-31** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **19** and **30**, the examiner fails to find support in Applicant's specification for the phrase "causing a first message to be displayed in two horizontal, adjacent blank quadrants, and the processor causing a second message to be displayed in a remaining blank quadrant," as currently claimed. Applicant provides paragraphs 9, 25, and Figure 5 of Applicant's specification as support for the amended phrase. The examiner fails to find any support for the amended phrase in either of paragraph 9 and paragraph 25 of Applicant's specification. Figure 5 of Applicant's specification illustrates a formatting feature for forms of messages. Applicant's specification states that various different formats can be used to display the text message. In Figure 4, a first text message format 402 includes a background color and a contrasting foreground color for the text. Second text message format 404 does not include a background color, but does provide brightly colored foreground text. After receiving and interpreting this formatting information, second STB 118 modifies the video signal that is being sent to second television 120, so that the text message is appropriately displayed (p. 3, paragraph 47 & Fig. 4). Figure 5 illustrates an example where the displayed image 410 is reduced leaving blank margin 412 below displayed image 410 and beside displayed image 410. Text can be

placed within blank margin 412. A third text message format 406 is placed in the horizontal portion of blank margin 412 and in another embodiment, a fourth text message format 408 provides text in the vertical portion of blank margin 412 (p. 3, paragraph 48 & Fig. 5). The examiner fails to find any support for “leaving second, third, and fourth quadrants as blank margins, the processor causing a first message to be displayed in two horizontal, adjacent blank quadrants, and the processing causing a second message to be displayed in a remaining blank quadrant,” as currently claimed. Figure 5 and the supporting paragraph only describe reducing the displayed image, thereby leaving a blank margin, and two different text formats that display a message either in the horizontal portion of the blank margin or the vertical portion of the blank margin. As such, the examiner fails to find support for the amended phrase.

Referring to claim **20**, the examiner fails to find support in Applicant’s specification for the phrase “the formatting information causing the message information to be displayed in the blank margin below the displayed image and in the another blank margin beside the displayed image” for the reasons stated above. Page 3, paragraph 48 of Applicant’s specification describes a blank margin and two different formats for displaying text information in the margin, either in the horizontal portion, or, in another embodiment, in the vertical portion of the margin (p. 3, paragraph 48). As such, the examiner fails to find support for this phrase in claim 20.

Claims **20-29** and **31** are rejected as being dependent on the above-mentioned independent claims.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **19-23, 25-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWeese et al. in view of Mimura et al. and further in view of August et al.

Referring to claims **19, 22, 29, and 30**, DeWeese et al. discloses a network for a subscriber's dwelling/set top box, comprising:

- an external line connection (communication path 24, 99, 101, 103, 105, 110, 112, 114) to an external signal source (Figs. 1A, 2A, 2B, 3);
- an internal wiring system 20 connected to the external line connection, the internal wiring system distributing signals from a service provider throughout the subscriber's dwelling (Figs. 1A, 10, 12);
- a back channel communications path that is different from the internal wiring system (p. 3, paragraphs 55, 56; p. 4, paragraph 59; p. 5, paragraph 71; & Fig. 1A, 2A, 2B, 3, 10);
- multiple set top boxes in communication with the internal wiring system, each set top box having a first input connected to the internal wiring system for receiving broadcasted content from the service provider (p. 3, paragraph 56 & Figs. 1A, 2A, 2B, 3, 10);

- each set top box having a first output adapted to be received by an associated television, the first output sending the broadcasted content to the television (p. 4, paragraph 65 & Fig. 1A);
- each set top box having a second input to receive message information from a user (p. 5, paragraph 67; p. 9, paragraphs 101, 105; & Figs. 1B, 10);
- each set top box having a second output connected to the back channel communications path (p. 3, paragraph 57 & p. 4, paragraph 59), each set top box sending message information from the second output to the back channel communications path for delivery to another of the multiple set top boxes, thus establishing a two-way intercom system between the multiple set top boxes (p. 5, paragraphs 71-73);
- when the message information is received at at least one of the multiple set top boxes, a processor in a receiving set top box receives text information along with formatting information from a sending set top box (p. 4, paragraph 60 & p. 5, paragraph 68), and the processor modifies a video signal received via the first input to the internal wiring system so that a displayed image is reduced in size to a first quadrant 315 of a display of the television (Fig. 16), thus leaving second 316, third 317, and fourth quadrants 318 as blank margins, the processor causing a first message to be displayed in two horizontal, adjacent blank quadrants 316, 317 (the examiner notes that the message "THINK" is displayed in quadrants 316 and 317)(Fig. 16), and the processor causing a second message 318 to be displayed in the remaining blank quadrant (video message)(p. 11, paragraph 119 & Fig. 16);

- means for updating the message information using private data received from the external line connection to the external signal source (p. 3, paragraphs 55, 57; p. 5, paragraphs 71-74; p. 7, paragraph 86; & Figs. 1A, 2A, 2B, 3, 10); and
- when a message is created, the message is first stored in memory for a time prior to being sent, then the message is retrieved from the memory and sent to a recipient's set top box (p. 5, paragraphs 68, 69; p. 6, paragraphs 76, 78; & p. 8, paragraphs 94, 98).

DeWeese et al. also discloses receiving television audio channels (p. 3, paragraph 56; p. 4, paragraph 64; & p. 9, paragraph 102). DeWeese et al. further discloses transmitting video chat images with audio as real-time communications by the chat system (p. 10, paragraphs 107, 111 & fig. 11). DeWeese et al. still further discloses that the video chat images and audio can be shown at the same time as a television program (p. 11, paragraphs 119, 120 & Figs. 16, 17). DeWeese et al. does not disclose that, when the message information has audible content, the message information is processed for another audio channel and a volume of the broadcasted content is reduced below a volume of the message information being played. Mimura et al. discloses a television audio/visual (A/V) conferencing system with a database 12. The AV database stores combinations of video signal characteristics and corresponding audio signal processing parameters, such as a volume of sound to be reproduced and a balance between sounds reproduced by loudspeakers (col. 9, l. 10-35). The processing parameters are read from the database and supplied to an audio signal processor to control the sound field to produce an acoustic space suitable for an image, by changing the sound volume and right and left balance to localize sounds based on the locality of displayed images (col. 6, l. 13-23; col. 20, l. 22-62; & Figs. 32A-33). It would have been obvious to one of ordinary skill in the art at the time that the

invention was made to modify the video and audio chat system of DeWeese et al. to include changing the sound volume and right and left balance of the received audio messages to be output from different speakers, such as that taught by Mimura et al. in order to provide a real-time TV conferencing system with improved reality (Mimura et al. col. 3, l. 36-45). The combination of DeWeese et al. and Mimura et al. does not teach reducing a volume of the audio signal below a volume of the received audible message information. August et al. discloses a set-top box 30 for receiving A/V and telephone signals. When a television viewer receives a telephone call over the set-top box, the audio signal emanating from the video receiving device can be automatically muted or reduced to a selectable level (col. 2, l. 46-64). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of DeWeese et al. and Mimura et al. to include reducing the volume of a television audio signal upon receiving an audio message, such as that taught by August et al. in order to provide the automatic interaction of desirable activities (August et al. col. 2, l. 56-68).

Referring to claim 20, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim 19, wherein the message information comprises text information and formatting information, the formatting information being preset and fixed such that the user is unable to change the formatting information, the formatting information causing a reduction in a size of a displayed image to create a blank margin below the displayed image and another blank margin beside the displayed image, the formatting information causing the message to be displayed in the blank margin below the displayed image and in the another blank margin beside the displayed image (p. 11, paragraph 119 & Fig. 16).

Referring to claim **21**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim **30**, wherein the audible message information comprises at least one of video information, text information, and a pre-formatted message (the examiner notes that chat sessions can have text, audio, video, or a combination, as well as additional appended information)(DeWeese et al. p. 3, paragraph 55; p. 4, paragraph 64; & p. 14, paragraph 141).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **23** and **25**, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claims **30** and **19**, respectively, wherein the memory stores pre-made voice messages (the examiner notes that chat sessions can be stored and viewed at a later time (DeWeese et al. p. 4, paragraph 64).

Referring to claim **26**, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claim **19**, further comprising a message waiting indicator (the examiner notes that when a message is received it appears in region 206)(DeWeese et al. p. 8, paragraph 93 & Fig. 9).

Referring to claims **27** and **31**, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claims **19** and **30**, respectively, further comprising another input adapted to receive information from a keyboard (DeWeese et al. p. 5, paragraph 67 & Fig. 1B).

Referring to claim **28**, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claim **19**, wherein the first input also receives a video signal

(DeWeese et al. p. 3, paragraph 56) and the set top box modifies the video signal to display a text message (DeWeese et al. p. 8, paragraph 93 & Fig. 9).

3. Claim **24** is rejected under 35 U.S.C. 103(a) as being unpatentable over DeWeese et al. in view of Mimura et al., further in view of August et al., and still further in view of Cowe et al.

Referring to claim **24**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim 19. The combination of DeWeese et al., Mimura et al., and August et al. does not specifically teach formatting information that, for urgent messages, replaces the displayed image with a blank background and displays the message information. Cowe et al. discloses a multi-channel audio messaging system for cable television for delivering public emergency alert information to members of the cable television audience (Abstract & col. 5, l. 47-53). Cowe et al. further discloses overlaying the video on every channel with a blank screen overlay and providing a full-screen text message to accompany the audio message (col. 11, l. 27-31). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the messaging system combination of DeWeese et al., Mimura et al., and August et al. to include overlaying video on channels with a blank screen overlay and a full-screen text message in the case of an emergency, such as that taught by Cowe et al. in order to provide an economical cable television messaging system that can override or substitute a video message on a multi-channel cable television system suitable for delivering public emergency alert information to members of the cable television audience (Cowe et al. col. 5, l. 47-53).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit
2623

MVH